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Corporate Patent Counsel
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EXAMINER

D AGOSTA, STEPHEN M

ART UNIT

PAPER NUMBER

2683

DATE MAILED: 07/15/2004

4

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/927,592

Applicant(s)

BULTHUIS, WILLEM

Examiner

Stephen M. D'Agosta

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

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Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 8-10-01 is in compliance and accordingly, the information disclosure statement is being considered by the examiner.

Drawings

The drawings were received on 2-5-02 and have been reviewed by the draftsperson and examiner.

Claim Objections

1. Claims "20-25" objected to because of the following informalities: these claims are incorrectly numbered – claim 19 was skipped, hence there are only 24 total claims. **Please renumber as claims "19-24" and fix dependencies (eg. claims 20-24 depend from claim 19 now).** Appropriate correction is required.

2. Claims 10 and 18 objected to because of the following informalities: the examiner believes the word "last" should be "least". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 19 provides for the use of a communications device that enables real-time communication, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 19 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5, 13-14, 17, 19 and 21-22 rejected under 35 U.S.C. 102(e) as being anticipated by Haimi-Cohen US 6,233,320 (hereafter Haimi-Cohen).

As per **claim 1**, Haimi-Cohen teaches a consumer electronics communication device comprising:

A first functionality adapted to enable real-time communications via the device (title, abstract, figure 4 and (C1, L8-12 teaches a digital phone);

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A second functionality adapted to enable automatic recording of at least part of the real time communication (C4, L15-20 and C5, L50-67 both teach record/playback of a real time phone conversation) in response to a user of the device initiating or accepting the real time communication (C1, L18-22 teaches "prior art" whereby the user activates a record feature – Haimi-Cohen teaches activation of a key on the phone keypad, C5, L58-62 to initiate recording which would be similar to an ON/OFF switch/controller as shown in prior art figure 1, #18 microcontroller).

As per **claim 2**, Haimi-Cohen teaches claim 1 wherein the first functionality comprises at least one user interface mechanism adapted to provide real-time audio and/or visual information to a user and to receive real-time audio and/or visual information from the user (figure 4 shows a wireless digital phone which inherently have a user interface/keypad (C5, L59-60) and provides for two-way real-time communication via wireless cellular standards such as CMDA, GSM or TDMA, C9, L22-27).

As per **claim 3**, Haimi-Cohen teaches claim 1 comprising a user input to enable the user to select a portion of the real-time communication for the recording (since Haimi-Cohen teaches prior art with an activation button to record as well as disclosing use of a keypad button to activate recordings (per claims 1-2 above), the examiner interprets the user "activating recording" as meaning he/she is able to select when recording starts/ends which reads on "a user input to enable the user to select a portion of communication to record".

As per **claim 5**, Haimi-Cohen teaches claim 1 comprising an onboard storage for storing at least part of the recorded communication (figure 4 shows Non-volatile Memory, #110 and C6, L28-31 and/or C7, L3-5).

As per **claim 13**, Haimi-Cohen teaches claim 1 wherein the device comprises a mobile phone functionality (title, abstract and C1, L5-12).

As per **claim 14**, Haimi-Cohen teaches a method comprising offering a service, the method comprising:

Enabling automatic recording of at least part of a real-time communication initiated or accepted by at least one subscriber (C4, L15-20 and C5, L50-67 both teach recording of a real time phone conversation); and

Responsive to at least one subscriber request, enabling playback of subscriber-selected ones of recorded real-time communications (C4, L15-20 and C5, L50-67 both teach playback of a real time phone conversation).

The examiner notes that Haimi-Cohen (C1, L18-22) teaches "prior art" whereby the user activates a record feature – Haimi-Cohen teaches activation of a key on the phone keypad, C5, L58-62 to initiate recording which would be similar to an ON/OFF switch/controller as shown in prior art figure 1, #18 microcontroller and reads on "initiated or accepted by a subscriber" and/or "responsive to a user request").

As per **claim 17**, Haimi-Cohen teaches claim 14 enabling the subscriber to select a portion of the real time communication for recording (since Haimi-Cohen teaches prior art with an activation button to record as well as disclosing use of a keypad button to activate recordings (per claims 1-2 above), the examiner interprets the user "activating recording" as meaning he/she is able to select when recording starts/ends which reads on "a user input to enable the user to select a portion of communication to record".

As per **claim 19**, Haimi-Cohen teaches for use with a consumer electronics communication device that enables real-time communications via the device (title, abstract and C5, L50-67 teaches a wireless phone) and a module with a storage for coupling with the device for enabling automatic recording of the real-time communication (Haimi-Cohen teaches a base station embodiment whereby the base station "couples" to the wireless phone and provides recording, C5, L57-60) in response to a user of the device initiating or accepting the real time communication (base station embodiment teaches user activating a key on keypad to record, C5, L59-60).

As per **claim 21**, Haimi-Cohen teaches claim 19 for coupling with the device using a wireless manner (C5, L50-67 teaches a wireless phone whereby the base station embodiment connects to said phone via wireless means, ie. CDMA, TDMA or GSM, C9, L22-27).

As per **claim 22**, Haimi-Cohen teaches claim 19 being controllable via a user-interface of the device (C5, L57-60 teaches the user controlling the recording via a phone key on the keypad).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 10-11, 15, 18 and 23 rejected under 35 U.S.C. 103(a) as being unpatentable over Haimi-Cohen as applied to claims 1, 14 and 19 above, and further in view of Silberfenig US 6,243,594 (hereafter Silberfenig).

As per **claim 4**, Haimi-Cohen teaches claim 1 **but is silent on** comprising at least one organizational mechanism for organizing recorded communications in a retrievable form for the user.

Silberfenig teaches operation via a play button 24 and that additional elements (eg. buttons) such as fast-forward, rewind, and message selection features can be added without altering the spirit of this invention (C5, L22-25). The examiner notes that Silberfenig "organizes" the recording(s) based on First In, First Out (FIFO) and a user would navigate (eg. forward/rewind) through a tape/memory for retrieval/playback based on the time of recording.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Haimi-Cohen, such that recordings are organized for retrieval, to provide means for the user to find what they are looking for (based on time recorded).

As per **claim 10**, Haimi-Cohen teaches claim 1 **but is silent on** comprising a last-communication rewind mechanism for replay of at least part of the communication recorded most recently.

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The examiner notes that most/all recording devices typically provide user controls such as Record, Erase, Fast Forward, Rewind, etc.. **Silberfenig** teaches a cell phone and sound/voice storage device that provides Record, Fast Forward, **Rewind**, etc. capabilities (C5, L22-25).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Haimi-Cohen, such that the unit has fast-forward/rewind capability, to provide user control means for the recording device.

As per **claim 11**, Haimi-Cohen in view of Silberfenig teaches claim 10 **but is silent on** wherein the last-communication rewind mechanism comprises a distinct, respective, physically actuable selector mechanism located on the exterior of the device.

Silberfenig teaches operation via a play button 24 and that additional elements (eg. buttons) such as fast-forward, rewind, and message selection features can be added without altering the spirit of this invention (C5, L22-25).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Haimi-Cohen in view of Silberfenig, such that the unit has fast-forward/rewind buttons, to provide user control means for the recording device.

As per **claim 15**, Haimi-Cohen teaches claim 14 **but is silent on** comprising organizing the recorded communications for retrieval and playback by at least one subscriber.

Silberfenig teaches operation via a play button 24 and that additional elements (eg. buttons) such as fast-forward, rewind, and message selection features can be added without altering the spirit of this invention (C5, L22-25). The examiner notes that Silberfenig "organizes" the recording(s) based on First In, First Out (FIFO) and a user would navigate (eg. forward/rewind) through a tape/memory for retrieval/playback based on the time of recording.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Haimi-Cohen, such that recordings are organized for retrieval, to provide means for the user to find what they are looking for (based on time recorded).

As per **claim 18**, Haimi-Cohen teaches claim 14 comprising offering subscribers a last-communication rewind feature for enabling to retrieve at least part of a copy of the real time communication recorded most recently.

The examiner notes that most/all recording devices typically provide user controls such as Record, Erase, Fast Forward, Rewind, etc.. **Silberfenig** teaches a cell phone and sound/voice storage device that provides Record, Fast Forward, **Rewind**, etc. capabilities (C5, L22-25).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Haimi-Cohen, such that a rewind capability is used, to provide user control means for the recording device.

As per **claim 23**, Haimi-Cohen teaches claim 19 **but is silent on** comprising at least one organizational mechanism for organizing the recorded communications in a retrievable form for the user

Silberfenig teaches operation via a play button 24 and that additional elements (eg. buttons) such as fast-forward, rewind, and message selection features can be added without altering the spirit of this invention (C5, L22-25). The examiner notes that Silberfenig "organizes" the recording(s) based on First In, First Out (FIFO) and a user would navigate (eg. forward/rewind) through a tape/memory for retrieval/playback based on the time of recording.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Haimi-Cohen, such that recordings are organized for retrieval, to provide means for the user to find what they are looking for (based on time recorded).

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Claim 6 rejected under 35 U.S.C. 103(a) as being unpatentable over Haimi-Cohen as applied to claim 1 and further in view of Schwartz et al. US 6,668,044 (hereafter Schwartz).

As per **claim 6**, Haimi-Cohen teaches claim 1 **but is silent on** comprising an output for transmitting a signal to a storage, the signal being representative of the real time communication for being recorded at the storage.

Schwartz teaches that the central archiving facility may be equipped with appropriate hardware and software to apply a time stamp to the call consistent with an accurate national time source to allow a "Certified Telephone Call" which reads on a signal being recorded representative of the real time communication being recorded (C8, L21-38).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Haimi-Cohen, such that a signal is outputted, to provide a timestamp that notes when the conversation was recorded.

Claims 7-9, 16, 20 and 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Haimi-Cohen as applied to claims 1, 14 and 19 above, and further in view of Ohshage et al. US 2002/0006188 (hereafter Ohshage).

As per **claim 7**, Haimi-Cohen teaches claim 1 **but is silent on** comprising an opt-out mechanism adapted to exempt a particular communication from being recorded.

Ohshage teaches recording of information/conversations between two mobile devices whereby one of the users can "opt-out" of the recording and thereby deny recording of the conversation (title, abstract, figures 1 and 3 and also see claim 2).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Haim-Cohen, such that an opt-out mechanism is used, to provide means for a party not to have their conversations recorded.

As per **claim 8**, Haimi-Cohen in view of Ohshage teaches claim 7 **but is silent on** wherein the opt-out mechanism comprises a prompter that asks as least the user or another part involved in the real time communication signal if there is a desire for omitting the recording.

Onshage teaches sending a party to the call a message asking if they wish to opt out of the recording (abstract and figure 3).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Haim-Cohen in view of Onshage, such that the opt-out mechanism asks a party if they wish to omit the recording, to provide means for the system to allow a user to decide if they want to have their conversation recorded or not.

As per **claim 9**, Haimi-Cohen in view of Onshage teaches claim 7 **but is silent** on the opt-out mechanism comprises a distinct, respective physically actuatable opt-out selector apparatus located on an exterior of the device.

Onshage teaches the party that wishes to opt-out must send back a response from their phone/device which inherently requires said party to operate a button on the keypad to respond (see claim 2) which reads on the opt-out mechanism being a separate selector on the exterior of the device. The examiner notes that one skilled would either provide for a multi-functional button (eg. soft key) that can perform various functions and takes less space (as per Ohshage) or use a single key/button to perform said function.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Haim-Cohen in view of Onshage, such that the opt-out mechanism is a button, to provide means for the user to use their phone keypad to send a message allowing/prohibiting recording.

As per **claim 16**, Haimi-Cohen teaches claim 14 **but is silent** on offering subscribers and/or interlocutors an opt-out feature so that given ones of their communications will not be recorded.

Onshage teaches recording of information/conversations between two mobile devices whereby one of the users can "opt-out" of the recording and thereby deny recording of the conversation (title, abstract, figures 1 and 3 and also see claim 2).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Haim-Cohen, such that an opt-out mechanism is used, to provide means for a party not to have their conversations recorded.

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As per **claim 20**, Haimi-Cohen teaches claim 19 **but is silent on** for galvanic coupling with the device.

Onshage teaches the recording/memory can be either fully incorporated into a mobile phone and/or attached as a module which is (galvanically) coupled (See paragraph "0033" - The embodiment of FIG. 1 requires inclusion of the voice recording circuit 11 and the memory 12 in the mobile phone 1, which means that a special telephone having these circuits must be used. As an alternative, the embodiment of FIG. 2 can be used. In this embodiment a separate accessory device 21 is connected to a standard GSM telephone 22. The voice recording circuit 11 and the memory 12 are included in the accessory device 21 and connected to the phone via a standard accessory connector 23. In any other respect the system of FIG. 2 works like that of FIG. 1).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Haimi-Cohen, such that the recording device can be galvanically coupled, to provide means for the user to upgrade to having record capability without them needing to buy a new integrated record/phone (eg. is an outboard module used with existing phones).

As per **claim 24**, Haimi-Cohen teaches claim 19 comprising an opt-out mechanism adapted to exempt a particular communication from recordation.

Onshage teaches recording of information/conversations between two mobile devices whereby one of the users can "opt-out" of the recording and thereby deny recording of the conversation (title, abstract, figures 1 and 3 and also see claim 2).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Haim-Cohen, such that an opt-out mechanism is used, to provide means for a party not to have their conversations recorded.

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Claim 12 rejected under 35 U.S.C. 103(a) as being unpatentable over Haimi-Cohen as applied to claim 1 and further in view of Nuovo et al. US 6,097,964 (hereafter Nuovo).

As per **claim 12**, Haimi-Cohen teaches claim 1 **but is silent on** comprising a thumbwheel for scrolling through recorded communications.

Nuovo teaches In accordance with the invention there is provided a telephone handset having a front surface with a display and a keypad, wherein said keypad includes a group of keys for entering alphanumeric signs and a key for navigating a cursor in the display, said navigation key is placed in the front surface of the phone between the display and the group of alphanumeric keys, said navigation key includes a roller body (eg. thumbwheel) which extends partly though an opening in the front surface of the phone, and which is essentially cylindrical with a length and diameter of the same size as the width of the keys in said group of keys for entering alphanumeric signs. With the roller concept according to the invention the roller body will have a well-defined axis of rotation, and by providing the roller body with a cylindrical shape a part of the micro mechanics may be placed internally in the roller (figure 1, #10, and figures 3-5, C1, L40-55)). Nuovo also discloses a Thumbwheel too (C1, L19-24).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Haim-Cohen, such that a thumbwheel is used for scrolling, to provide ease-of-use for the user to scroll through a list of names, functions, etc..

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

1. Brown et al. US 5,535,261.
2. Kek et al. US 6,072,860

3. Hall US 6,021,325
4. Cannon et al. US 6,430,270
5. Park US 6,246,489
6. Hein et al. US 6,580,903
7. Hashimoto US 4,833,704

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 703-306-5426. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stephen D'Agosta

